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REMARKS

In the Final Office Action, the Examiner indicated that the Applicants' Rule 131 Declaration and associated evidence is ineffective to overcome the Melker et al. reference and, thus, the Examiner finally rejected claims 16-42. For the reasons set forth below, the Applicants respectfully traverse the Examiner's dismissal of the foregoing Rule 131 Declaration and associated evidence as *allegedly* insufficient to overcome the Melker et al. reference. In addition, the Applicants respectfully assert that the pending claims are patentably distinct from the prior art in view of certain claim features, which are clearly missing from Melker et al. Accordingly, the Applicants respectfully request reconsideration and allowance of all pending claims.

Deficiencies of Examiner's "Response to Amendment"

First, the Examiner incorrectly applied the requirements set forth in 37 C.F.R. § 1.131 (hereinafter, "Rule 131"). In the Final Office Action, the Examiner asserted that the "evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Melker et al. reference." Final Office Action mailed 08/11/2004, Page 3 (emphasis added). The Examiner continued by stating that the "evidence submitted in Exhibit A is insufficient to establish due diligence from prior to the effective date of the Melker et al. reference to a subsequent reduction to practice or to the filing of the application." *Id.* (emphasis added). The Applicants respectfully stress that the Examiner has misapplied the requirement Rule 131. According to Rule 131, the Applicants may overcome a patent that is prior art under 35 U.S.C. § 102(e) by filing an appropriate declaration that establishes either:

reduction to practice prior to the effective date of the reference, or
conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application.

37 C.F.R. § 1.131(b) (Rev. July 1, 2004) (emphasis added). In the Applicants' previous Response to Final Office Action, the Applicants submitted a Rule 131 Declaration and associated evidence to prove actual reduction to practice prior to the effective date of the Melker et al.

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reference. Therefore, the Examiner's remarks relating to *conception* and *due diligence* are completely improper and insufficient to address the sufficiency of the Applicants' Rule 131 Declaration and associated evidence relating to *actual reduction to practice*. For this reason, the Applicants respectfully request that the Examiner correctly analyze the Rule 131 Declaration and associated evidence or withdraw the rejections based on Melker et al.

Second, the Examiner's Office Action is clearly incomplete. Specifically, the Examiner did not completely review the independent claims 16, 28, and 34. In the Final Office Action, the Examiner stated that the "declaration is deficient in the showing of conception because it lacks evidence of providing a collaborative computing environment between a trainee and a remote trainer for a medical diagnostic imaging system; and interactively instructing the trainee." Final Office Action mailed 08/11/2004, Page 3. In view of this statement, the Applicants stress that the Examiner has analyzed only independent claim 1, while completely ignoring the other independent claims 28 and 34. 37 C.F.R. § 1.104(b) states that the "examiner's action will be complete as to all matters." The Examiner's failure to review any claims other than independent claim 1 clearly evidences the Examiner's failure to meet the requirements of 37 C.F.R. § 1.104(b).

Third, the finality of this first Office Action is clearly improper, because the Examiner required the Applicants to file a Request for Continued Examination (RCE) in order to consider the new issues that were raised by the Rule 131 Declaration and associated exhibits. The Applicants emphasize that:

However, it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of the prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised.

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M.P.E.P. (Rev. 2, May 2004) § 706.07(b), Page 700-76. The foregoing applies equally to a first Office Action following an RCE. *See* M.P.E.P. (Rev. 2, May 2004) § 706.07(h)(VIII), Page 700-92. In the previous Advisory Action, the Examiner clearly denied entry of the Rule 131 Declaration and associated exhibits, thereby forcing the Applicants to file an RCE. *See* Advisory Action mailed June 9, 2004. Although the Examiner commented that the Rule 131 Declaration and associated exhibits were not timely presented, the Applicants emphasize that these documents also presented new issues that required further consideration. Therefore, in view of M.P.E.P. §§ 706.07(b) and (h), the finality of the present Office Action must be withdrawn.

In addition, the Applicants believe that the finality of the present Office Action is improper for not providing a full and fair hearing. Specifically, the Applicants stress that the "examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal." M.P.E.P. (Rev. 2, May 2004) § 706.07, Page 700-73. Applicants believe that the Examiner has unfairly closed prosecution without fully and clearly developing the issues pertaining to the Rule 131 Declaration and associated exhibits. Again, "present practice does not sanction hasty and ill-considered final rejections." *Id.* For these reasons among others, the Applicants respectfully request that the Examiner withdraw the finality of the present Office Action.

Fourth, the Applicants stress that the previously submitted Rule 131 Declaration and associated exhibits do, in fact, establish actual reduction to practice of the claimed invention prior to the effective date of the Melker et al. reference. As discussed previously, the Rule 131 Declaration of inventor Robert Laferriere demonstrates that the invention disclosed and claimed in the present application was actually reduced to practice prior to the effective date of Melker et al. Specifically, in paragraph 4 of the Rule 131 Declaration, the applicant/inventor declares that the invention disclosed and claimed in the present application was *actually reduced to practice at least as early as March 2000*. The effective date of Melker et al. is no earlier than June 30, 2000,

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provided that the provisional application supports the claims of the issued Melker patent. Although Applicants reserve the right to challenge this effective date, the issue is not relevant at this time. In view of the Applicants' earlier reduction to practice, the Applicants respectfully request that the Examiner withdraw Melker et al. from consideration and withdraw the rejections based on Melker et al.

In addition, the Applicants stress that the Rule 131 Declaration and associated exhibits are clearly commensurate in scope with the instant claims and, thus, this evidence is believed to be more than sufficient to swear behind the Melker et al. reference. Regarding the sufficiency of the Rule 131 Declaration and associated exhibits, the Applicants stress that the Rule 131 declaration must establish possession of either the whole invention claimed or something falling within the claims (such as a species of a claimed genus), in the sense that the claim as a whole reads on it. See *In re Tanczyn*, 347 F.2d 830, 146 U.S.P.Q. 298 (C.C.P.A. 1965); see also M.P.E.P. (Rev. 2, May 2004) § 715.02, Page 700-244. Furthermore, even if the applicant's Rule 131 declaration is not fully commensurate with the rejected claim, the applicant can still overcome the rejection by showing that the differences between the claimed invention and the showing under Rule 131 would have been obvious to one of ordinary skill in the art, in view of applicant's Rule 131 evidence, prior to the effective date of the cited reference. See M.P.E.P. (Rev. 2, May 2004) § 715.02, Page 700-244. In view of the foregoing, the Applicants believe that the Rule 131 Declaration and associated exhibits sufficiently evidence possession of the invention commensurate in scope with the claims. The Applicants also note that an accompanying exhibit need not support all claimed limitations, provided that missing limitations are supported by the declaration itself. See *Ex parte Ovshinsky*, 10 U.S.P.Q.2d 1075 (Bd. Pat. App. & Inter. 1989); see also M.P.E.P. (Rev. 2, May 2004) § 715.07(I), Page 700-250. Again, the Applicants believe that the previously filed exhibits sufficiently disclose the claim features, yet the Applicants rely on the Rule 131 Declaration for any feature which the Examiner believes to be missing from the exhibits. For these reasons, Applicants reiterate that the Examiner should remove Melker et al. from consideration in view of the previously filed Rule 131 Declaration and associated exhibits.

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Additional Evidence to Swear Behind Melker et al.

Although the Applicants do not believe any further evidence is needed to swear behind Melker et al., the Applicants are willing to submit an additional Rule 131 Declaration and/or additional exhibits to swear behind Melker et al. in the unlikely event that the Examiner maintains the objection to the previously filed Rule 131 Declaration and associated exhibits. However, if the Examiner requests additional evidence, then the Applicants respectfully request that the Examiner provide a copy of the original provisional application 60/215,574 upon which the Melker et al. reference, U.S. Patent No. 6,535,714, claims priority. If the provisional application does not support the subject matter of Melker et al., U.S. Patent No. 6,535,714, then the filing date of this provisional cannot be used as the effective date of Melker et al., U.S. Patent No. 6,535,714. Again, if the Examiner requests additional evidence, then the Applicants respectfully request an opportunity to file such evidence to develop the issues fully and fairly before proceeding to an Appeal.

Rejections Under 35 U.S.C. § 102

In the Final Office Action, the Examiner rejected claims 16-17, 23-25, and 27 under 35 U.S.C. § 102(e) as anticipated by Melker et al. In view of the foregoing removal of Melker, the Applicants respectfully request withdrawal of these rejections. In addition, the Applicants traverse the Examiner's rejection for the reasons set forth below.

Legal Precedent

First, when construing claims, the Federal Circuit has consistently looked first to dictionaries, encyclopedias, and treatises, which were publicly available at the time the patent issued, to determine the ordinary and custom meanings of terms used in claims. As stated in *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202-03 (Fed. Cir. 2002):

Such references are unbiased reflections of common understanding not influenced by expert testimony or events subsequent to the fixing of the intrinsic record by the grant of the patent, not colored by the motives of the parties, and not inspired

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by litigation. Indeed, these materials may be the most meaningful source of information to assist judges in better understanding both the technology and the terminology used by those skilled in the art to describe the technology.

The *Texas Digital* court further stated that “[c]onsulting the written description and prosecution history as a threshold step in the claim construction process, before any effort is made to discern the ordinary and customary meanings attributed to the words themselves, invites a violation of our precedent counseling against importing limitations into the claims.” *Id.* at 1204 (cited with approval in *Intellectual Property Development Inc. v. UA-Columbia Cablevision of Westchester Inc.*, 67 U.S.P.Q. 2d 1385, 1389 (Fed. Cir. 2003)).

Second, Applicants remind the Examiner that, during patent examination, the pending claims must be given an interpretation that is reasonable and consistent with the specification. See *In re Prater*, 415 F.2d 1393, 1404-05, 162 U.S.P.Q. 541, 550-51 (C.C.P.A. 1969); see also *In re Morris*, 127 F.3d 1048, 1054-55, 44 U.S.P.Q.2d 1023, 1027-28 (Fed. Cir. 1997); see also M.P.E.P. §§ 608.01(o) and 2111. Interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. See *In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); see also M.P.E.P. § 2111. As further explained in Section 2111.01 of the M.P.E.P., the words of the claim must be given their plain meaning unless the applicant has provided a clear definition in the specification. See *In re Zletz*, 893 F.2d 319, 321, 13 U.S.P.Q.2d 1320, 1322 (Fed. Cir. 1989). Again, the plain meaning refers to an interpretation by those of ordinary skill in the art. See *In re Sneed*, 710 F.2d 1544, 218 U.S.P.Q. 385 (Fed. Cir. 1983).

Third, anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under section 102, a single

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reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, the Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention "in as complete detail as contained in the ... claim" to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Fourth, if the Examiner relies on a theory of inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999) (Emphasis Added). The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. *Id.* In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The Examiner, in presenting the inherency argument, bears the evidentiary burden and must adequately satisfy this burden. *See id.* Regarding functional limitations, the Examiner must evaluate and consider the functional limitation, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. *See* M.P.E.P. § 2173.05(g); *In re Swinehart*, 169 U.S.P.Q. 226, 229 (C.C.P.A. 1971); *In re Schreiber*, 44 U.S.P.Q.2d 1429, 1432 (Fed. Cir. 1997). If the Examiner believes the functional limitation to be inherent in the cited reference, then the Examiner "must provide some evidence or scientific reasoning to establish the reasonableness of the examiner's belief that the functional limitation is an inherent characteristic of the prior art." *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Inter. 1986).

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Deficiencies of Melker et al.

Independent claim 16 recites "providing a *collaborative computing environment* between a trainee and a remote trainer" and "*interactively instructing* the trainee via the *collaborative computing environment*." (Emphasis added).

First, the Applicants stress that the Examiner has improperly interpreted the foregoing claim features, thereby leading to an improper comparison of claim 16 versus Melker et al. The ordinary meaning of "collaborate" may be defined as "to work with another or others" or "to cooperate." THE RANDOM HOUSE COLLEGE DICTIONARY 263 (Rev. Ed. 1988). In context of independent claim 16, the collaborative computing involves cooperation between multiple parties, i.e., the trainee and the remote trainer. This interpretation is reasonable and consistent with the specification, which clearly discloses sharing, collaboration, and interaction between a trainee and a remote trainer. One of ordinary skill in the art would most reasonably interpret these claim features to provide *collaboration* between *both* the trainee and the trainer, but not in a *one-sided* or non-cooperative manner. Again, the Applicants stress that the Federal Circuit has consistently looked first to dictionaries, which were publicly available at the time the patent issued, to determine the ordinary and custom meanings of terms used in claims. *See Texas Digital*, 308 F.3d at 1202-03. Moreover, the pending claims must be given an interpretation that is reasonable and consistent with the specification. *See* M.P.E.P. §§ 608.01(o) and 2111. For these reasons, the Applicants believe that independent claim 16 cannot be anticipated by a one-sided or non-cooperative control of a computer by a single user.

Second, in contrast to independent claim 16, Melker et al disclose *device simulation* training for a single user, but not between two different users (e.g., a trainer and trainee). *See* Melker et al., Col. 2, lines 52-54 and 65-67; Col. 6, lines 3-20. In other words, Melker et al. provides only a "training interface between the user and the device." Melker et al., Abstract; Col. 4, lines 60-63. As discussed above, collaboration within the scope of the present claims is much more than mere *one-sided* remote control or viewing by a *single user*. Given that the

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Melker et al. reference does not disclose more than a single user that interacts with a simulated image of a device (not another user), this reference absolutely cannot anticipate the features of independent claim 1.

In view of these deficiencies, Applicants respectfully assert that independent claim 16 and its respective dependent claims 17, 23-25, and 27 are patentable over Melker et al. Accordingly, Applicants respectfully request that the Examiner withdraw the rejections under 35 U.S.C. § 102.

Rejections Under 35 U.S.C. § 103

In the Final Office Action, the Examiner rejected claims 18-22, 26, and 28-42 under 35 U.S.C. § 103(a) as unpatentable over Melker in view of Edlund et al. (U.S. Patent No. 6,085,227; hereinafter Edlund). In view of the foregoing removal of Melker, the Applicants respectfully request withdrawal of these rejections. In addition, the Applicants traverse the Examiner's rejection for the reasons set forth below.

Legal Precedent

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the references taught or suggested *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and

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thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Moreover, the Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

Deficiencies of Melker et al. and Edlund et al.

Turning to the claims, independent claim 28 recites, *inter alia*, "sharing a graphical user interface" and "collaboratively interacting." Independent claim 34 recites, *inter alia*, "*a user interface shared by the first and second computing systems for collaboratively interacting with the medical diagnostic imaging system.*"

Again, the Applicants stress that the claimed user interface is *shared for collaborative* interaction with the medical diagnostic imaging system, rather than a *one-way* or *one-sided* interface permitting only viewing or one-sided control. One of ordinary skill in the art would most reasonably interpret these claim features to provide *sharing between at least two computing environments or systems*, but not a mere *one-sided* control or viewing. As discussed above, the ordinary meaning of "collaborate" may be defined as "to work with another or others" or "to cooperate." THE RANDOM HOUSE COLLEGE DICTIONARY 263 (Rev. Ed. 1988). In other words, the claimed feature of "collaboratively interacting" involves cooperation, rather than mere one-sided control or viewing. Furthermore, the ordinary meaning of "share" may be defined as "to use, participate in, enjoy, receive, etc., jointly." THE RANDOM HOUSE COLLEGE DICTIONARY 1209 (Rev. Ed. 1988). In other words, the claimed sharing of a user interface involves joint use and participation of such user interface, rather than a one-sided control or viewing.

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Regarding the cited references, the Melker et al. reference is devoid of the claim feature "collaboratively interacting" for the reasons discussed in detail above with reference to claim 16. In addition, the Examiner conceded that Melker et al. do not disclose *sharing* a graphical user interface. See Paper No. 4, page 5. Accordingly, the Melker et al. reference is missing at least these two features.

Turning to the secondary reference, the Applicants stress that Edlund et al. do not obviate the deficiencies of the Melker et al. reference. Instead, Edlund et al. merely disclose a *one-sided* system for remote control and observance, which is antithetical to *collaboratively interacting*. See Edlund et al., Col. 1, lines 31-42; Col. 2, lines 4-36; Col. 4, lines 47-48; and Col. 4, lines 50-63. The remote functions disclosed by Edlund et al. are only *one-sided* and completely lack any sort of collaboration. For the reasons set forth above, Edlund et al. do not teach or suggest the "collaboratively interacting" feature missing from Melker et al.

Applicants also stress that the user interface disclosed by Edlund et al. is a typical *unshared* interface, rather than a *shared* user interface as recited in independent claims 28 and 34. See Edlund et al., Col. 3, lines 47-52; Col. 4, lines 15-23. Edlund et al. is clearly directed to "operating remote devices over wide area networks such as the Internet." Edlund et al., Abstract. However, the Edlund et al. reference does not even mention sharing or anything remotely equivalent to sharing, much less sharing a user interface. The Applicants reiterate that the ordinary meaning of "share" may be defined as "to use, participate in, enjoy, receive, etc., jointly." THE RANDOM HOUSE COLLEGE DICTIONARY 1209 (Rev. Ed. 1988)(emphasis added). The remote control disclosed by Edlund et al. cannot reasonably be interpreted to encompass *joint* use, participation, or enjoyment of the devices. For these reasons, Edlund et al. do not teach or suggest the *shared* user interface feature missing from Melker et al. If the Examiner wishes to maintain this rejection, then the Applicants challenge the Examiner to identify a specific passage discussing "sharing" of a user interface as set forth in the instant claims.

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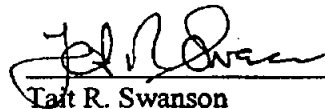
In view of these deficiencies, the cited references taken alone or in combination fail to teach or suggest the features recited in the independent claims 28 and 34. Accordingly, Applicants respectfully request that the Examiner withdraw the Section 103 rejection of independent claims 28 and 34 and their respective dependent claims.

Conclusion

The Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

Date: November 3, 2004



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